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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
08 444,994	05 19 1995	PETER PALESE	6923-054	5839

7590 05/20/2003

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1155 AVENUE OF THE AMERICAS  
NEW YORK, NY 100362711

EXAMINER

PARKIN, JEFFREY S

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

08/444,994

Applicant(s)

PALESE ET AL.

Examiner

Jeffrey S. Parkin, Ph.D.

Art Unit

1648

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 April 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 06 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 24 April 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ they raise the issue of new matter (see Note below);  
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
5. ☒ The a) ☐ affidavit, b) ☒ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see below.  
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to \_\_\_\_\_

Claim(s) rejected: 2-8, 11, 12, 14-17 and 57-74.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.  
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_  
10. ☒ Other: See Continuation Sheet

**LAURIE SCHEINER**  
**PRIMARY EXAMINER**

Continuation of 10. Other: Applicants are reminded that appropriately drafted claim language directed toward those embodiments receiving adequate support (e.g., NPI-1-6) in the specification would be allowable. As previously set forth, the disclosure only provides detailed structural information pertaining to a single influenza virus NP interacting protein (NPI-1). While other NPIs were identified (NPI-2 6), detailed structural and functional information was not provided. Exhibit C (Gyuris et al., 1993) was provided to demonstrate that protein-protein interaction assays were known in the art at the time of filing. The Examiner does not dispute this finding, however, many of these assays (e.g., yeast-two-hybrid) are preliminary screening mechanism to identify POTENTIAL binding partners for any given protein. Since these assays are screening large libraries of compounds, the skilled artisan cannot reasonably predict what type of partner will bind to the protein of interest. Concerning Exhibit D (Wang et al., 1997), applicants are reminded that in order to overcome a prima facie case for lack of enablement, applicants must demonstrate that the disclosure was enabled as of the filing of the application (see M.P.E.P. § 2164.05(a)). Publications dated after the filing date providing information publicly first disclosed after the filing date generally cannot be used to show what was known at the time of filing. In re Gunn, 537 F.2d 1123, 1128, 190 U.S.P.Q. 402, 405-06 (C.C.P.A. 1976). In re Budnick, 537 F.2d 535, 538, 190 U.S.P.Q. 422, 424 (C.C.P.A. 1976). Moreover, the publication relied upon only provides a preliminary nexus between two of the NPIs, specifically NPI-1 and -3. It fails to provide a detailed molecular analysis of the determinants modulating interactions between other NPIs. Moreover, it is not clear that the other NPIs identified all share a well-conserved structural feature that modulates binding interactions with the NP. The other NPIs could recognize different protein domains within the NP and perform different functions than NPI-1 and -3. Therefore, the claims stand rejected for the reasons of record clearly set forth in the last Office action..